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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/306,986 05/07/99 TRINH

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HM12/1107  
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EXAMINER

HUTSON, R

ART UNIT

PAPER NUMBER

1652

DATE MAILED:

11/07/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**

Application No.

09/306,986

Applicant(s)

TRINH ET AL.

Examiner

Richard G Hutson

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 October 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 8-13,38-55.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: Interview Summary

Continuation of 2. NOTE: Applicants proposed amendment of claim 8 to include the recitation, "desired nucleic acid template" introduces new issues after final rejection, such as the 112 1<sup>st</sup> issues of support for such an amendment, as well as 112 2<sup>nd</sup> issue of the meaning of such an amendment. Further proposed new claims 56-69 add new issues that would require additional search after final such as in claim 56, the source of cell or tissue; in claim 57, use of genomic DNA as a template; in claim 63, template is contained in a cloning vector, etc....

Continuation of 5. does NOT place the application in condition for allowance because: Applicants traverse the previous 112, second paragraph rejection on the basis that the term "crude preparation" is described in the specification as a preparation that contains some nucleic acids that have been released from cells without the need for purification of the nucleic acid from the cells. Applicants point to the specification page 20, lines 7-12 as supporting their argument and ask that further explanation be given as to why the term "crude preparation" is indefinite. In response to applicants argument, the indefiniteness of the term "crude preparation" can be seen in the differing interpretations of this term by the applicants and the examiner with respect to the previous art rejections.

Applicants continue to argue that the Maudru et al. reference does not teach the claimed methods because Maudru et al. start with a "pure" RNA , and it is unlikely that one of ordinary skill in the art would consider a "purified RNA and its cDNA" as a "crude preparation". As in the previous office actions, this argument is not found persuasive, because as previously stated it is believed that such a preparation of RNA and cDNA would be considered a crude preparation, absent proof otherwise.

Applicants traverse the rejection by Don et al. in a similar manner as the above traversal of the Maudru rejection. This is similarly not found persuasive.

Applicants additionally traverse the 103 rejection based on either Maudru et al. or Don et al. as above on the basis that neither reference teaches or suggests the use of a "crude preparation" as a starting material. As discussed above and in the previous office actions, this argument is not found persuasive for the reasons previously stated.

*Rebecca Burtz*  
PRIMARY EXAMINER  
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